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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,456	08/30/2001	Michael D. Myers	12606-1	3931

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EXAMINER

HONG, STEPHEN S

ART UNIT

PAPER NUMBER

2178

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Please find below and/or attached an Office communication concerning this application or proceeding.

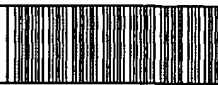
Office Action Summary

Application No.
09/945,456

Applicant(s)
Myers et al.

Examiner
Stephen Hong

Art Unit
2178



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 15, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Part III DETAILED ACTION

1. This action is responsive to communications: amendment filed and RCE filed on April 15, 2003 to the application, filed on August 30, 2001.
2. In the amendment claims 10-12 are added. Accordingly, claims 5-12 are pending in the case. Claim 5 is an independent claim.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors.

In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the

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obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103[©] and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Legal Anywhere Collaborator Version 3.0, Legal Anywhere, LLC, 1997, the product described in pages 1-4 of <http://http://web.archive.org/web/19981202150347/www.legalanywhere.com/TLI.htm>.

The claims are rejected based on the product called Legal Anywhere Collaborator, which is a file management and collaboration tool for attorney practitioners (see page 1, under "Product Overview" section). The Legal Anywhere Collaborator allows the "coordinate and manage workflow between attorneys and their clients, staff, co counsel, and virtually any party involved in the process of delivering legal services. (see page 1, first paragraph)"

As per independent claim 5, Legal Anywhere Collaborator teaches the following claimed features of a method for processing data request from clients of particular practitioners on a distributed computer network:

- maintaining a main document database (page 3, "either ...on site at the law firm's... or ..on our premises");

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- registering the practitioners (see page 3, "Who would use this product?", different attorneys are set up to use the system);

- processing document selections of the practitioners to identify respective home document sets of the practitioners (on page 4, for example, "...can access document that a colleague could make available on their intranetnthrond.." teaches only a necessary set of documents are given access to per practitioner.);

- identifying requesting users as clients of corresponding practitioners (on page 2, second paragraph, "allows for attorneys and ...clients ...to exchange legal documents", teaches recognition of the client);

- processing client requests for permitting access by particular clients to the home document sets of corresponding practitioners and transmitting requesting pages of the home document sets to the particular clients (page 2, in the second paragraph, since the clients can only access documents relating to their own legal matters.).

However, the Legal Anywhere Collaborator does not appear to explicitly disclose that the processing document selections of the practitioners occur "from the main document database" to identify respective home document sets. Nevertheless, Legal Anywhere Collaborator teaches the use of the system where "[t]he remote attorney.. that work from home or that are on the road ...access documents located at the their central offices. (last line on page 3)" Since the Legal Anywhere Collaborator selects the home document sets based on the identification of the user, Legal Anywhere Collaborator clearly suggests that the central

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database at the central offices performs the processing of the document selection. Therefore, given the teaching, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have implemented Legal Anywhere Collaborator system with the processing document selections of the practitioners such that the processing occurs "from the main document database" to identify respective home document sets.

As per dependent claims 6 and 7, Legal Anywhere Collaborator teaches maintaining a practitioners database, and including practitioner-specific and client-specific portions of the database in pages being transmitted to the particular client (page 4, "provides access control so that an outside attorney can access document" shows practitioner specific page access; and page 2, in the second paragraph, show client specific).

As per dependent claims 8 and 9, Legal Anywhere Collaborator teaches maintaining client data and tracking client access to the home document sets (page 2, in the third paragraph, "Document ...tracking and storage").

As per dependent claims 10, Legal Anywhere Collaborator teaches receiving data from a provider, and using the data to form the main document database (page 3, line 3, "allowing for the law firm to host ..on our website" since the data is to be provided by the firm).

As per dependent claims 11 and 12, Legal Anywhere Collaborator does not explicitly disclose maintaining a subscriber navigation path for registering specific practices of each subscriber and practitioners of each practice; and maintaining a client navigation path for identifying the home document sets of the practitioners to the clients of the corresponding

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practice. Nevertheless, Legal Anywhere Collaborator discloses that the Legal Anywhere Collaborator company can host the websites for different subscribers (page 3, lines 1-3). Furthermore, Legal Anywhere Collaborator teaches that the security and data structures are maintained for the different firms who choose to host their websites at Legal Anywhere Collaborator's server (page 3, line 5, "our premises...with added security and structure"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have maintained the navigation paths of the subscribers and clients in LAC, since Legal Anywhere Collaborator explicitly pointed out that the security and the structure are provided to ensure only the authorized users get access to the data.

Response to Arguments

6. Applicant's arguments with respect to claims 5-9 have been considered but are moot in view of the new ground(s) of rejection.

On page 5, of the argument, Applicant states:

It is believed that the rejection of claims 5-9 under 35 U.S.C. 103 is no longer appropriate in view of the amendment of claims 5 requiring at least some of the practitioners to be affiliated with different specific practices of subscribing entities having access to the main document database. It is noted that different subscribers disclosed in the LAC reference contribute separate collections of documents that are not generally available to other subscribers. Thus, **although the practitioners of a single subscriber of LAC may have access to all of the documents of that subscriber, they do not have access to the documents of other subscribers except to the extent authorized by the other subscribers.**

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In response to the argument, Examiner points out that as Applicant admits in the bold sentence above, LAC allows the **“the practitioners...[to have the] access to the documents of other subscribers ...[at least to] the extent authorized by the other subscribers.”** In other words, nothing in the claimed language precludes the access though it may be by the authorization by the other subscribers, as long as at least some practitioners have the access to other subscribers' data. Accordingly, the Applicant's arguments are not persuasive.

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

After-final (703) 746-7238
Official (703) 746-7239
Non-Official/Draft (703) 746-7240

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).



Stephen Hong

Primary Examiner

June 12, 2003